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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/764,855 | 01/26/2004 | Gennady V. Katzyn | KKGG01-CON | 9793 |

7590 04/01/2005

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| EXAMINER | |
|------------------|--------------|
| TUCKER, PHILIP C | |
| ART UNIT | PAPER NUMBER |

1712

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,855

Applicant(s)

KATZYN ET AL.

Examiner

Philip C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to an oil well capsule, classified in class 507, subclass 269.
 - II. Claim 13, drawn to a method of reducing and preventing asphaltene and paraffin accumulations, classified in class 166, subclass 312.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the capsule may be used in other processes, such as preventing hydrate formation.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Kurt Rylander on 12/16/04 a provisional election was made without traverse to prosecute the invention of I, claims 1-12.

Affirmation of this election must be made by applicant in replying to this Office action.

Claim 13 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-7 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by RU 2105867.

The translation of RU '867 supplied by applicant is relied upon in this rejection. RU '867 teaches an oil well capsule which has a shell made of aluminum foil, which contains an alkaline metal, having a hollowed core, which can contain aluminum powder. Such capsule is used to reduce paraffin, asphaltene and hydrate formation in wells. As in claims 5 and 10 the shell may contain a coating of bitumen. As in claims 2 and 7, the capsule may comprise a coating of paraffin.

3. Claims 1, 3-6, 8-10, 12, 14, 15, 31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by RU 2122628.

The translation of RU '628 supplied by applicant is relied upon in this rejection. RU '628 teaches an oil well capsule which has a shell made of aluminum foil, which contains an alkaline or alkaline earth metal, having a hollowed core, which can contain

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aluminum powder. Such capsule is used to reduce paraffin, asphaltene and hydrate formation in wells. As in claims 5 and 10 the shell contains a coating of bitumen.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 6, 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over RU 2105867.

The translation of RU '867 supplied by applicant is relied upon in this rejection. RU '867 teaches an oil well capsule which has a shell made of aluminum foil, which contains an alkaline metal, having a hollowed core, which can contain aluminum powder. Such capsule is used to reduce paraffin, asphaltene and hydrate formation in wells. RU '867 differs from the present invention in that the density of the capsule is not taught as being more than one gram per centimeter cubed. RU '867 however teaches that weighting agents such as barite or silica sand are used in the capsule. It would be obvious to one of ordinary skill in the art to utilize varying amounts of weighting agent in order to achieve sufficient density for achieving passage of the capsule through the well at a proper speed.

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6. Claims 1, 3, 6, 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over RU 2122628.

The translation of RU '628 supplied by applicant is relied upon in this rejection. RU '628 teaches an oil well capsule which has a shell made of aluminum foil, which contains an alkaline or alkaline earth metal, having a hollowed core, which can contain aluminum powder. Such capsule is used to reduce paraffin, asphaltene and hydrate formation in wells. RU '628 differs from the present invention in that the density of the capsule is not taught as being more than one gram per centimeter cubed. RU '628 however teaches that weighting agents such as iron or lead are used in the capsule. It would be obvious to one of ordinary skill in the art to utilize varying amounts of weighting agent in order to achieve sufficient density for achieving passage of the capsule through the well at a proper speed.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 1, 3-6 and 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/243802. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of 10/243802 differ in teaching the additional use in gas lift wells and wells having no artificial obstructions, the capsule may comprise the same shell and active mass as in the present invention, and thus the present claims would be rendered obvious to one of ordinary skill in the art in view of the claims of 10/243802.

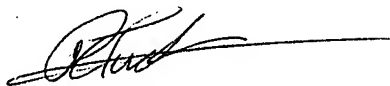
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip C Tucker
Primary Examiner
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PCT-3309